

Appln. No.: 10/631,071  
Response dated Feb. 20, 2008  
Reply to Office action of Aug. 20, 2007

## **REMARKS**

Claims 30-298 were pending at the time of the Office Action.

Claims 48-49, 119-187, 211, 213 and 244-298 stand rejected under 35 U.S.C. § 112, ¶ 1 for allegedly failing to comply with the written description requirement.

Claims 48-49, 119-187 and 244-298 stand rejected under 35 U.S.C. § 112, ¶ 2 for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 48-49, 119-187 and 244-298 stand rejected under 35 U.S.C. § 101 for allegedly overlapping two different statutory classes of invention.

Claims 30-47, 50-118, 188-210, 212 and 214-243 stand allowed.

Claims 152, 213 and 268 have been canceled without prejudice.

New claims 299-302 have been added by the present amendment.

For at least the reasons stated below, the Applicants traverse the rejections of claims 48-49, 119-187, 211, 213 and 244-298 and submit that all pending claims, including new claims added by the present amendment, are allowable.

## **Amendment to the Specification**

The specification has been amended at page 15, line 28 to page 16, line 3 to add statements from Appendix C, pages 67-68. An implementation of the features described in these statements, and/or associated features, is contained in the code of Appendix B. Appendices B and C are described in the specification at page 1a, lines 14-24 and page 43, lines 3-17.

## **Rejections under 35 U.S.C. § 112, ¶ 1**

Claims 48-49, 119-187, 211, 213 and 244-298 stand rejected under 35 U.S.C. § 112, ¶ 1 for allegedly failing to comply with the written description requirement. The Office Action, at § 4, states that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the

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time the application was filed, had possession of the claimed invention. The Applicants respectfully traverse such rejections.

Regarding claims 48 and 49, and their respective dependent claims 119-187 and 244-298, the Office Action states, "Claims 48-49, and their dependents thereof, recite an electrical circuit. However, an electrical circuit was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." The Applicants respectfully disagree.

Claims 48 and 119-187 are generally apparatus counterparts to method claims 44 and 50-118. Also, claims 49 and 244-298 are generally apparatus counterparts to method claims 45 and 188-243

The roaming terminals and bridging nodes discussed in the specification inherently include electrical circuitry. In addition, the specification refers in many instances to a software implementation. For example, col. 9, lines 21-22 state, "The software for the spread-spectrum system is functionally layered as follows." The specification then (*e.g.*, in col. 9, line 25 to col. 16, line 21) discusses such layered software implementation, including the bridging layer, the logical link control layer, network layer and transport layer, including various aspects of network and mobile terminal operation (*e.g.*, sleep mode operation). The specification also includes Appendices A-C, which include source code listings in the "C" programming language. The Applicants also submit that the software nature of the disclosed exemplary embodiment inherently supports the disclosed functionality of the specification being performed by a processor or processing circuitry configured to execute such software. Thus, the Applicants respectfully submit that the specification supports a roaming terminal and/or bridging node having electrical circuitry that comprises at least one processor configured to perform the disclosed functionality (*e.g.*, by executing software instructions). For at least this reason, the Applicants submit that claims 48-49, 119-187, 211, 213 and 244-298 are allowable in view of 35 U.S.C. § 112, ¶ 1.

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The Applicants further submit that, while the exemplary implementation presented in the specification is primarily a processor/software implementation, the scope of various aspects of the present invention should not be limited to only a processor executing software instructions (*e.g.*, in contemplation of one or more processor/software functions being implemented in discrete processor hardware).

Regarding claims 152, 213 and 268, such claims have been canceled without prejudice. Thus, the rejection of such claims is moot.

Regarding claims 150, 211 and 266, such claims recite wherein the first message is a beacon message. The Office Action, at § 4, states that “a beacon message was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention”. The Applicants respectfully disagree with this statement.

For example, the Applicants submit that the term “beacon” is widely used in the field of communication for anything serving as a signal for guidance (*e.g.*, to inform nodes of broadcast transmissions, synchronize multiple nodes, and provide location references). The HELLO message of the specification is an example of a beacon. Interestingly, the term “beacon” was first introduced into the lineage of the present application by a PTO Examiner via Examiner amendment during prosecution of the 08/395,555 application, which ultimately issued as U.S. Patent No. 5,740,366, the great grandparent of the present application. Accordingly, the Applicants submit that the term “beacon” is supported in the present specification by way of the non-limiting example of the HELLO message.

#### **Rejections under 35 U.S.C. § 112, ¶ 2**

Claims 48-49, 119-187 and 244-298 stand rejected under 35 U.S.C. § 112, ¶ 2 for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicants respectfully traverse this rejection.

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The Office Action, at § 5, states that claims 48 and 49 (and thus independent claims 119-187 and 244-298) are directed to an electrical circuit comprising a processor that operates to perform a process. The Applicants agree.

Then the Office Action, at § 5, states that a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. § 112, ¶ 2. The Applicants agree that MPEP § 2173.05(p) makes such a statement. The Applicants, however, disagree that a claim comprising a processor that operates to (or is configured to) perform a process is a claim that “claims both an apparatus and the method steps of using the apparatus”.

For example, MPEP § 2173.05(g) discusses functional limitations, stating “a functional limitation is an attempt to define something by what it does rather than by what it is (*e.g.*, as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). ... A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.”

Applying MPEP § 2173.05(g) to claims 48 and 49 (and their respective associated dependent claims), the Applicants submit that such claims each define their respective “at least one processor” by what it does rather than by what it is (*e.g.*, as evidenced by its specific structure). Accordingly, the Applicants respectfully submit that claims 48-49, 119-187 and 244-298 are allowable under 35 U.S.C. § 112, ¶ 2 when considered in light of MPEP § 2173.05(g).

### **Rejections under 35 U.S.C. § 101**

Claims 48-49, 119-187 and 244-298 stand rejected under 35 U.S.C. § 101 for allegedly overlapping two different statutory classes of invention. The Applicants respectfully traverse these rejections.

The Office Action, at § 8, states, “because the claims are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention set

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forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551. See MPEP 2173.05(p).”

The Applicants notice that again, the Office Action quotes the language from MPEP § 2173.05(p), which as discussed above, does not apply to the present claims, which describe the claimed “at least one processor” by what it does rather than by particular structural features. As discussed above, claims 48-49 and their associated dependent claims are clearly covered by MPEP § 2173.05(g), which states that “there is nothing inherently wrong with defining some part of an invention in functional terms”. Accordingly, the Applicants respectfully submit that claims 48-49, 119-187 and 244-298 are allowable under 35 U.S.C. § 101.

### **New Claims**

The present amendment adds new claims 299-302. New claims 299 and 300 each depend from claim 44 and thus are allowable for at least the reasons for which claim 44 is allowable. The Applicants also submit that new claims 299 and 300 are each independently allowable. New claims 301 and 302 each depend from claim 48 and thus are allowable for at least the reasons for which claim 48 is allowable. The Applicants also submit that new claims 301 and 302 are each independently allowable.

### **Final Matters**

The Office Action makes various statements, including statements regarding previously pending claims 30-298, 35 U.S.C. § 112, 35 U.S.C. § 101 and one or ordinary skill in the art that are moot in light of the amendments and/or arguments presented previously. Thus, though a portion of such moot statements were addressed above, the Applicants did not address all of such moot statements at the present time. The Applicants, however, explicitly reserve the right to challenge any of such statements in the future should the need arise (*e.g.*, if such statements should become relevant by being stated in a future rejection of any claim).

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**Summary**

In summary, the Applicants respectfully submit that the various rejections stated in the Office Action have been overcome with regard to claims 30-298. The Applicants also submit that new claims 299-302 are allowable. Accordingly, the Applicants courteously solicit an expeditious notice of allowance for all pending claims. If the Examiner disagrees or has questions regarding this submission, the Applicants respectfully request that the Examiner telephone the undersigned at 312-775-8000.

The Commissioner is hereby authorized to charge additional fee(s) or credit overpayment(s) to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: Feb. 20, 2008

Respectfully submitted,

/Shawn L. Peterson/

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